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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,299	02/12/2002	Robert Rieger	21300.105009	6408
20786 7590 01/29/2007 KING & SPALDING LLP 1180 PEACHTREE STREET ATLANTA, GA 30309-3521			EXAMINER BARTLEY, KENNETH	
			ART UNIT	PAPER NUMBER
			3693	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/29/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/074,299	RIEGER ET AL.	
	Examiner	Art Unit	
	Kenneth L. Bartley	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/17/2002</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 1-44 have been examined.

#### *Drawings*

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because drawings 10-14 are too dark. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.
3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show reference 1410 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "appetites" in claim 38 is used by the claim to mean "quantity of loans", while the accepted meaning is "inherent craving" (Merriam-Webster Online Dictionary). The term is indefinite because the specification does not clearly redefine the term.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 7-19 and 21-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub. No. US 2003/0144945 to Opsahl-Ong, et al..

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

7. Regarding applicant claims 1-5, 7-19, and 21-44, Opsahl-Ong, et al., discloses:
- a. "...systems and methods to automatically generate a return target for a potential real estate deal...(para. 6);

- b. A computer system that provides fast and reliable deal quotes to customers and deal originators so that the focus can be on real estate deals "more likely to be approved." (bottom of para. 51);
- c. Information can include collateral type or a market risk associated with a potential real estate deal (bottom of para 24). Consideration of geographic market could be part of the market risk, and in fact geographic information is considered in an example of buildings in the same city (para. 51);
- d. A system that helps ensure that transactions meet "any applicable criteria for risk and profitability at pricing levels acceptable to customers." (para. 76);
- e. Deal information may include amount of loan, deal term, collateral quality information (para. 31), commitment and/or exit fee (para. 44), development deal information (para 33), and net income from the real estate deal (para. 34);
- f. Calculating a return on the investment value (based on product specific information) to determine the potential (probability or likelihood) of a deal being approved (para. 48);
- g. Debt transaction can be associated with a mortgage-backed security, equity, or existing debt (para. 23);
- h. A "prior deal database" that can be used to create a rule-based pricing model (para. 60 and 61);
- i. A "minimum return target" based on LIBOR (market hurdle) required for a potential deal to be approved (bottom of para. 34);

- j. A base loan spread increased with at least one risk adder and decreased with at least one mitigant to generate a target loan spread (para. 8);
- k. Determination of a "base return target" (bottom of para. 43), supplemental information used to determine both additive and mitigating risk factors, including Debt Service Coverage Ratio (DSCR) as a parameter (para 44 and 45);
- l. Base return target available from a "matrix of values" (para. 36). While Opsahl-Ong, et al., does not detail use of the matrix of values, it would be possible to adjust each value to provide minimum, maximum and cutoff curves from the data;
- m. A base loan spread determined from loan-to-value ratio and can be increased or decreased based on supplemental information (para. 8);
- n. A storage device for a program controlling a processor (57);
- o. A deal originator "may input property, market, and structural information associated with a potential deal and get a target price that will be needed to get...that particular deal approved" (para. 50) based on a decision tool;
- p. Calculation of return targets (a range of acceptable prices) based on different risk factors (para. 49);
- q. A risk-rating above a pre-determined threshold can be used with the deal-controller (para. 46);

- r. A "deal system" that includes a Web server adapted to perform calculations and provide real-time results and a communication network for a deal originator (para. 26 and 27, Fig. 1);
- s. A customer may provide supplemental deal information to the deal controller (para. 80);
- t. Data source can include a number of properties and current LIBOR (para. 44);
- u. Use of customer "tier" information (para 32), which can be used by an investor for help in finding desirable transactions (bottom of para. 45).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.



10. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being obvious over Pub. No. US 2003/0144945 to Opsahl-Ong, et al., in view of Smith and Mosier (Sidney Smith and Jane Mosier, "Guidelines for Designing User Interface Software," MITRE Corporation, August 1986).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

11. Regarding claims 6 and 20, while Opsahl-Ong, et al., teaches different price levels, including a minimum and target price, they do not teach displaying a minimum, maximum, and cutoff curve on a graph. However, Smith and Mosier provide guidelines (Sect. 2.4.2 and 2.4.3) for displaying two-dimensional curves from computer systems

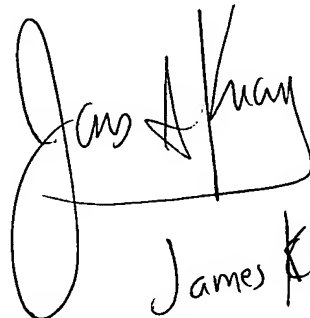
Art Unit: 3693

that can be used to show data trends, correlations, or other derived statistical measures for a graphic display. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a graphical display of the data motivated by the need of both customer and client to quickly interpret whether a potential (mortgage) deal meets certain requirements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth L. Bartley whose telephone number is (571) 272-5230. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 1/22/07  
James Kramer